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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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INTEL/BLAKELY
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

EXAMINER	
TRAORE, FATOUMATA	
ART UNIT	PAPER NUMBER
2136	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,973	SMITH, NED M.	
	Examiner	Art Unit	
	FATOUMATA TRAORE	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,10-15,33-37 and 42-47* is/are pending in the application.

4a) Of the above claim(s) *16-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,10-15,33-37 and 42-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This in response of the amendment filed December 13th, 2007. Claims 16-32 have previously been withdrawn; Claims 6-9 and 38-41 have been cancelled; Claims 1, 10, 11, 33, 42 and 43 have been amended; Claims 1-5, 10-15, 33-37 and 42-47 are pending in this application and have been considered below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33-47 stands rejection, applicant amended the claims to recite the limitation of a "tangible storage medium", and submitted that "As amended herein, claim 33 recites "a tangible storage medium having ... instructions stored thereon. Applicant respectfully submits that a tangible storage medium storing instructions cannot include a signal as it is defined in the Office Action. Therefore, the rejection of these claims is overcome". As stated on the previous office action, paragraph [105]) defined the computer readable medium to include but not be limited to , solid-state memories, optical and magnetic disks, and a ***carrier wave***. The Office considers an electronic signal to be a form of energy. Energy is not a series of steps or acts and this is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a compilation of matter. Thus, an electronic transmission signal does not fall within any of the four categories of invention. Appropriate correction is required.

Response to Arguments

3. Applicant's arguments filed December 12th, 2007 have been fully considered but they are not persuasive.

Applicant stated on page 9 of the reply that "Per the Office Action at page 6, Uusitalo fails to disclose a user key and a platform key". However, the examiner notes that claims 7-9 depend of claim 6 which recites the limitation of "wherein encrypting the master secret comprises digitally signing the master secret with one or more certified keys" and claims 7-9 recalls for a certified platform key and a certified user key. The previous rejection of claims 7-9 indicated that Uusitalo et al fails to teach a certified user key and a certified platform key. However, claim 1 as amended recites the limitation of" signing the master secret with multiple authentication facets of the endpoint, the multiple authentication facets including ***a user key representing a particular user and a platform key representing the particular endpoint platform***" therefore, the examiner submits that Uusitalo et al teaches the limitation of claim 1 as amended see(paragraph [0032] a user key representing a particular user(*in addition to the IMSI it is proposed here that a secret key k is also stored on the SIM card. This key is known only to the network operator and to the user* **(user key)**) and a platform form key representing a particular endpoint platform (when a subscriber registers with the operator of a 3GPP network, he or she receives a Subscriber Identity Module (*SIM) card on which is stored a unique International Mobile Subscriber Identity (IMSI) code (***platform key***)).

Also, on page 10 of the reply, Applicant stated "*As discussed above, Uusitalo fails to disclose or suggest the use of user and platform keys*" the examiner submits that as discussed above, Uusitalo et al fails to teach a certified platform key and a certified user key not a user key and a platform key. Therefore, the examiner submits that Uusitalo et al discloses each and every feature of claim 1 as amended. Claim 33 recites similar limitations as claim 1, thus Uusitalo et al discloses each and every features of claim 33.

There is no new ground of rejection when the basic thrust of the rejection remains the same. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). To the extent that the response to the applicant's arguments may have mentioned new portions of the prior art references, which were not used in the prior office action, this does not constitute new a new ground of rejection. It is clear that the prior art reference is of record and has been considered entirely by applicant. See In re Boyer, 363 F.2d 455,458 n.2,150 USPQ 441,444, n.2 (CCPA 1966) and In re Bush, 296 F.2d 491,496, 131 USPQ 263,267 (CCPA 1961).

The mere fact that additional portions of the same reference may have been mentioned or relied upon does not constitute new ground of rejection. In re Meinhardt, 392, F.2d 273,280, 157 USPQ 270, 275 (CCPA 1968).

Accordingly, this office action is being made final.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 10-13, 15, 33-37, 42-45 and 47 are rejected under 35 U.S.C. 102 (e) as being anticipated by Uusitalo et al (US 2005/0063544).

Claims 1, 33: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals comprising:

i. Cryptographically hashing a platform configuration value representing a configuration state of an endpoint platform to generate a cryptographic hash of the platform configuration (*for security reasons secret key (k) may not be used directly to encrypt traffic, but rather some traffic encryption key (TEK) is derived from the PMK k (e.g. by taking a hash of the PMK) (paragraph [0048])*;

ii. Mixing the cryptographically hashed cryptographic hash of the platform configuration with a pre-master secret via a hash algorithm to generate a master secret (*paragraph [0049]*); and

iii. Negotiating a communication channel (paragraph [0035]);

iv. Signing the master secret with multiple authentication facets of the endpoint (*paragraph [0048]*), the multiple authentication facets including a user key representing a particular user and a platform key representing the particular endpoint platform (*paragraph [0032]*);

v. Authenticating the negotiated communication channel with the signed master secret to establish the negotiated communication channel as a secure channel (*paragraphs [0048], [0051]*).

Claims 2, 34: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 1 and 33 above, and further discloses that the platform private key is bound to the platform configuration using a trusted platform device when a subscriber registers with the operator of a 3GPP network, he or she receives a Subscriber identity Module (SIM) card on which is stored a unique International Mobile Subscriber Identity (IMSI) code (paragraph [0032]).

Claims 3, 35: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 2 and 34 above, and further discloses that the trusted platform device comprises a processor coupled to a protected storage device (paragraph [0053]; Fig .7).

Claims 4, 36: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 1 and 33 above, and further discloses a step of cryptographically hashing the platform configuration comprises cryptographically hashing the platform configuration using a secure hashing algorithm (a pseudo-random function such as a keyed hash (or MAC, Message authentication code) such as SHA-1 or MD5 or the 3GPP Milenage algorithm)(paragraph [0032]).

Claims 5, 37: **Uusitalo et al** discloses a method and article of facilitating the

lawful interception of an IP session between two or more terminals as in claims 4 and 36 above, and further discloses that the secure hashing algorithm comprises Secure Hashing Algorithm Version 1.0 (SHA-1) (paragraph [0032]).

Claims 10-11, 42-43: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 1 and 33 above, and **Uusitalo et al** further discloses wherein the platform configuration includes multiple identities (Fig. 2) and the platform key includes one or more platform identity keys(paragraph [0032]).

Claims 12, 44: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 1 and 33 above, and further discloses a step of enabling the encrypted master secret to be decrypted at another endpoint, wherein the master secret is used by each endpoint to generate the session keys (paragraphs [0013], [0036], [0050]).

Claims 13, 45: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 1 and 33 above, and further comprises:

a. Exchanging an explanation of the platform configuration hashes following session key negotiations to finalize the authentication (paragraph [0032]);

b. Verifying, at both endpoints, key exchange messages, certificates and platform configuration data (paragraphs [0053], [0088]); and

c. Authenticating the session if no problems arise during verification (paragraphs [0053], [0054]).

Claims 15, 47: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 13 and 45 above, and further discloses a step of enabling endpoints to exchange data, wherein each endpoint knows that the platform from the other endpoint has been authenticated using a platform identity that ties to the trusted platform module (paragraph [0032]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 14 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Uusitalo et al** (US 2005/0063544) in view of **Bass et al** (US 4649233).

Claims 14, 46: **Uusitalo et al** discloses a method and article of facilitating the lawful interception of an IP session between two or more terminals as in claims 13 and 45 above, but does not explicitly discloses a step of halting the authentication. However, Bass et al discloses a method and article to support secure data transfer, which further discloses a step of halting the authentication session if problems arise during

verification (column 4, lines 35-51). Therefore, it would have been obvious for one having ordinary skills in the art at the time the invention was made to include a step of halting the authentication. One would have been motivated to do so in order to prevent unauthorized access to critical data.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fatoumata Traore whose telephone number is (571) 270-1685. The examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:00 p.m. and every other Friday from 7:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nassar G. Moazzami, can be reached on (571) 272 4195. The fax phone number for Formal or Official faxes to Technology Center 2100 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 270-2685.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-2100.

FT
Wednesday March 5, 2008

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2136